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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,960	01/26/2001	Jo Ann H. Squier	10247	7021

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ExxonMobil Chemical Company
P.O. Box 2149
Baytown, TX 77522

EXAMINER
SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
1772	8

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

Office Action Summary	Application No.	Applicant(s)	
	09/770,960	SQUIER ET AL.	
	Examiner	Art Unit	
	Catherine Simone	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 24** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "adapted to be" in claim 24 is deemed vague and indefinite. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1-8** and **10-26** rejected under 35 U.S.C. 103(a) as being unpatentable over Balaji et al. (6,150,013) in view of Bright (5,897,722).

Balaji et al. discloses a thermoplastic label comprising a first skin layer comprising a thermoplastic (see col. 3, lines 23-43) and a first cavitating agent (see col. 5, lines 4-16) wherein the first skin layer (Fig. 1, #14) has a first side and a second side and the first skin layer is cavitated. However, Balaji et al. fails to disclose a cold glue adhesive on the first side of the first

skin layer. Bright teaches in the analogous art a cold glue adhesive (see col. 4, lines 39-41) for the purpose of adhering a label to an article.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a cold glue adhesive on the first side of the first skin layer in Balaji et al. as suggested by Bright in order to adhere a label to an article.

Regarding **claim 3**, the thermoplastic is polyethylene (see col. 3, lines 25-29). Regarding **claim 11**, the first skin layer comprises at least about 15% by weight of the thermoplastic label (see col. 9, lines 4-6). Regarding **claims 12** and **13,** note the first cavitating agent is selected from the group consisting of polyamides, polybutylene terephthalate, polyesters, acetals, acrylic resins, nylons, solid performed glass spheres, hollow performed glass spheres, ceramic spheres, metal beads, metal spheres, calcium carbonate (see col. 4, lines 20-23 and col. 5, lines 5-16). Regarding **claims 14** and **15**, note the label has a thickness from about 3 mils. to about 5 mils. (see col. 4, lines 50-53). Regarding **claim 16**, note the label is biaxially oriented (see col. 4, line 56). Regarding **claims 17, 18** and **19**, the first cavitating agent comprises at least about 25% by weight, at least about 35% by weight and at least about 50% by weight of the first skin layer (see col. 5, lines 37-45). Regarding **claim 20**, the polypropylene comprises homopolymer polypropylene (see col. 5, line 9). Regarding **claim 21**, the polypropylene comprises homopolymer polypropylene (see col. 5, line 9) and wherein the cavitating agent comprises at least about 25% by weight of the first skin layer (see col. 5, lines 37-45). Regarding **claim 24**, note a first skin layer (Fig. 1, #14) comprising polypropylene (see col. 3, lines 40-43) and a first cavitating agent (see col. 5, lines 4-16) wherein the first skin layer has a first side and a second side and the first skin layer is cavitated (see col. 3, lines 53-55).

Regarding **claim 24**, process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation "a cold glue applied to the first side of the first skin layer" is a method of production and therefore does not determine the patentability of the product itself.

Regarding **claim 24**, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison,* 69 USPQ 138.

Regarding **claims 2** and **6**, Balaji et al. discloses the claimed invention except for the first skin layer having a thickness of at least about 0.3 mils. and the tie layer having a thickness of at least about 0.3 mils. However, Balaji et al. teaches film thickness (see col. 4, lines 50-53). Thus,

one of ordinary skill in the art would have recognized that the thickness of the claimed first skin layer and the thickness of the claimed tie layer would be readily determined through routine experimentation depending on the desired end results as shown by Balaji et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Balaji et al.'s first skin layer with a thickness of at least about 0.3 mils. and tie layer with a thickness of at least about 0.3 mils., since Balaji et al. shows that the thickness of the first skin layer and the thickness of the claimed tie layer would be readily determined through routine experimentation depending on the desired end results. Furthermore, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art absent a showing of unexpected results. *In re Boesch,* 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding **claim 4**, note a core layer comprising polypropylene and a second cavitating agent (see col. 4, lines 6-23) wherein the core layer (Fig. 1, #16) has a first side and a second side and the first side of the core layer is adjacent to the second side of the first skin layer (Fig. 1, #14). Regarding **claim 5**, note a tie layer (see col. 4, lines 31-36) comprising polypropylene. Regarding **claims 7** and **8**, note a second skin layer comprising polypropylene (see col. 3, lines 40-43 and col. 8, lines 29-33). Regarding **claim 10**, the core layer is cavitated (see col. 3, lines 58-60). Regarding **claims 22** and **23**, note the second cavitating agent is selected from the group consisting of polyamides, polybutylene terephthalate, polyesters, acetals, acrylic resins, nylons, solid performed glass spheres, hollow performed glass spheres, ceramic spheres, metal beads, metal spheres, calcium carbonate (see col. 4, lines 20-23 and col. 5, lines 5-16).

5. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Balaji et al. (6,150,013) in view of Bright (5,897,722) and further in view of Katsura et al. (5,223,315).

Balaji et al. discloses a thermoplastic label comprising a first skin layer comprising a thermoplastic (see col. 3, lines 23-43) and a first cavitating agent (see col. 5, lines 4-16) wherein the first skin layer (Fig. 1, #14) has a first side and a second side and the first skin layer is cavitated wherein the first side of the first skin layer is adapted to be used in contact with a cold glue adhesive. However, both Balaji et al. and Bright fail to disclose a metal layer. Katsura et al. teaches a metal label layer (see col. 10, lines 28-31) is known in the art for the purpose of providing a metallic gloss to the label and improving the decorative effect.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a metal layer in Balaji et al. as suggested by Katsura et al. in order to provide a metallic gloss to the label and improve the decorative effect.

Response to Arguments

6. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new grounds of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Catherine Simone
Examiner
Art Unit 1772

December 9, 2002

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

12/10/02